REMARKS

In view of the above amendments and foregoing remarks, favorable reconsideration in this application is respectfully requested. New claims 86-96 are submitted, and it is respectfully submitted that those claims be examined with the elected claims. No new matter has been added.

Nonelected Claims

The Examiner requests that the nonelected claims be canceled. Applicant hereby authorizes the Examiner to cancel the nonelected claims if a notice of allowance would otherwise be issued. Otherwise, Applicant has left the nonelected claims pending in case the Examiner reconsiders the restriction. In addition, claims 49 and 50 are now dependent on elected claim 44. It is respectfully submitted that claims 49 and 50, as well as new claims 86-96, be examined with claim 44.

Specification

The Examiner objects to the abstract and title. A new abstract and title are submitted herewith to comply with the Examiner's objections.

Claim Rejection – 35 U.S.C. §101

The Examiner indicates that claims 73-75 are not limited to tangible embodiments because it includes both tangible (*e.g.*, an article of manufacture) and intangible (*e.g.*, a computer-readable medium having stored thereon instructions) embodiments. Applicant disagrees that a computer-readable medium having stored thereon instructions is an

intangible aspect. Without limitation, well-known computer-readable mediums include, for instance, a hard drive, diskette or CD-ROM. Those tangible items store instructions which, when performed by a processor, cause the processor to execute certain steps. It is respectfully submitted that such computer-readable mediums are clearly tangible.

Claim Rejection – 35 U.S.C. §112, First Paragraph

The Examiner contends that the specification does not disclose a computer-readable medium having stored thereon instructions. Applicant refers the Examiner to at least original claim 14, which refers to a computer-readable medium having instructions. In addition, it should be understood that computer hardware (such as computer hardware platform 1091 and operating system 1090) implements software having instructions. At page 19, line 10, it is noted that the hardware platform provides disk storage for the program used to implement the invention. Accordingly, it is respectfully submitted that the specification provides sufficient written description of that aspect of the invention.

Claim Rejection – 35 U.S.C. §102

The Examiner rejects claims 44, 45, 52, 58-60 and 73-75 as being anticipated by Drummond, and also as anticipated by Leeds.

Initially, it should be noted that Drummond does not qualify as prior art to the present invention. Drummond was filed on March 10, 2000, whereas the present invention is a CIP of an application filed in 1999. The present claims have support with the original application and therefore are entitled to the earlier filing date.

The claimed invention requires that the system determine whether the sender address exist "without sending an electronic mail message to the sender address." The present invention uses discrete protocol transactions (claim 45) to determine if an authorized mailhost will accept e-mail for a particular address. Within the Simple Mail Transfer Protocol (SMTP), these transactions are SMTP commands such as "RCPT To:", and the authorized mailhost will respond almost immediately with a numeric response, such as "250" to indicate that the authorized mailhost will accept mail for that recipient, or "550" to indicate that the authorized mailhost will not accept mail for that recipient.

Neither Drummond nor Leeds suggest that less than an entire e-mail can be sent. Instead, those patents generate and issue to the sending address a new e-mail requesting a return acknowledgement from the sender. (Drummond, col. 6, ll. 27-29; Leeds, Fig. 4 ("Create automatic Message Reply 1 using Reply to Field") and col. 5, ll. 50-52 and 63-64 ("When verifying that a user is a valid user by sending a verification request in the form of an e-mail message...")).

Thus, Drummond and Leeds typically require three e-mail messages: (1) the incoming message, (2) a message back to the sender address, and possibly (3) a response from the sender or in Leeds a non-delivery notice. In Leeds, the automatic return message to an address that does exist is an added step which is an annoyance to the sender. In Drummond, the human sender must reply to the automatic return message in order for his or her initial message (1) to be delivered. The present invention does not require messages (2) and (3) but instead uses protocol transactions that are invisible to a human sender to determine existence of the sender address.

There are certain disadvantages with using e-mail messages to verify sender addresses, as in Drummond and Leeds. Those systems must distinguish between incoming messages (1) and (3), taking into account the possibility of different languages and message formats. The present invention, in contrast, receives only message (1) and immediately makes its decision based upon a numeric response observed by all mail servers on the Internet. Moreover, those systems may need to store message (1) for hours or even days while waiting for a human response (Drummond) or a non-delivery notice (Leeds). The present invention verifies most sender addresses within a few seconds, while the remote host is connected, and before accepting the message header and other message content.

At paragraph 13 of the office action, the Examiner contends that Drummond teaches sending a "test transaction" on a "test connection" and "determining if the authorized mailhost affirmatively accepts the sender address as a recipient." According to claim 45, the test transaction is less than an entire e-mail and only requires that the sender address be specified. An entire e-mail does not teach claim 45 since claim 44 requires that an e-mail not be sent. In contrast, Drummond sends an e-mail message, and does not teach the use of discrete protocol transactions (*e.g.*, SMTP commands) transactions or commands. Further, Drummond teaches that a person must respond in accordance with instructions in the challenge, so it is not the mailhost in the prior art that authorizes the sender address, but the human sender that confirms the e-mail. (Col. 7, ll. 4-55 and 52-55: "The goal, of course, is to issue an e-mail that requires a human response and/or to make it very difficult for an automated spam machine to respond correctly.") The Examiner makes the same statements

regarding Leeds. But, as with Drummond, Leeds sends complete messages rather than test transactions.

Further, the system in Leeds involves parsing bounce (non-delivery) notifications, which may vary according to the language and/or e-mail software used by the remote server. Leeds teaches a test of deliverability. (Col. 5, line 45 and Figure 4). This deliverability test may fail for various reasons other than non-existence of the user address. For example, the sender's system may not generate separate non-delivery notices, users may exceed their storage limits, or user spam filters may discard the Leeds verification request without reading it. The claimed invention of determining the existence of the sender address at an authorized mailhost does not suffer from these disadvantages of Leeds. The Leeds system must separate the incoming stream of messages into (a) actual messages, which may require address verification, and (b) response or non-delivery notices, each of which has its own complexities. In contrast, the protocol interactions used by the present invention are distinct from delivery status messages and are necessary if the sender address exists and is configured to receive e-mail.

At paragraphs 15-17 of the Office Action, the Examiner cites Leeds (col. 4, ll. 37-59) as teaching "automatically sending a reply (in the form of a verification request) to the purported sender(s)," and automatically deleting the message "if the verification request is undeliverable (as determined by the receipt of the corresponding verification response)." Even if Leeds operated in terms of protocol interactions (which Leeds does not say it does), such a description would still be fundamentally different from the system described in the present invention. Leeds would have to send and receive 2-3 separate e-mail messages and

parse the text of these messages. In contrast, the present invention involves only one e-mail message and does not require receiving the text of that e-mail message.

Further, the present invention determines whether the sender's address exists at an authorized mailhost for the domain of the sender address. The claims selectively accept a message based on the existence of the sender address at an authorized domain. The prior art does not teach or suggest this aspect of the claimed invention. Indeed, Leeds does not even mention the term "domain", except when mentioning the title of a prior art document. (Col. 1, lines 31-33).

Accordingly, it is respectfully submitted that the present invention is patentable over each of Drummond and Leeds, whether considered separately or in combination. The prior art does not teach determining whether the sender address exists without sending an e-mail to the sender, or determining whether the sender address exists at an authorized mailhost for a domain of the sender address.

In the event there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (110768.00102). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicant hereby petitions under 37 CFR 1.136(a) for an

extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

BLANK ROME LLP

By: _____
Peter S. Weissman
Reg. No. 40,220

600 New Hampshire Ave., N. W.
Washington, D.C. 20037
Telephone: (202) 944-3000
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